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REMARKS

Undersigned counsel gratefully acknowledges the interview with Examiner Zele on February 14, 1997. Unfortunately, the substance of the interview was not in the Interview Summary. The issue discussed at the interview was whether a Rule 131 affidavit need only overcome the date of a publication, and need not overcome a prior date referred to in the publication, but not in the public domain. Apparently there was no communication from Examiner Zele to Examiner Matar that the date of the Economist article cannot be carried back two and one half years without showing another publication or public use or other evidence of the earlier date. The Office Action fails to address the preliminary amendment that replaced the June 18, 1997 one. Therefore, the Official Action does not address the record in this case.

The Examiner asked for a new preliminary amendment in late August, 1997. It was submitted before the Official Action of August 29, 1997, but the Examiner never even bothered to consider it. Great effort went into preparing the new preliminary amendment to avoid the requirement for a substitute specification, a new matter rejection and many of the claim rejections. However, even though the Examiner asked for it, he never paid any attention to it. It does not advance the prosecution of this case to ignore the amendment filed August 28, 1997. The Response to Amendment in paragraph 3 (page 3) of the Official Action is **not** responsive to the amendment requested by the Examiner.



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With respect to paragraph 4 (page 3) of the Official Action, all of the objections have been taken care of by the foregoing amendment and by the Preliminary Amendment that was not considered by the Examiner.

With respect to the art rejections, it is appropriate to set forth the efforts of applicant to expedite prosecution of this case. New counsel was retained to expedite the issuance of a patent on the invention of this application, because the parent case has been on appeal for two years, with no prospect for a decision in the foreseeable future. There is widespread infringement of the invention, and the international call-back market may end in a few years. It is therefore imperative to advance the prosecution as quickly as possible.

In order to advance the prosecution as quickly as possible, new counsel took several steps. First, undersigned counsel filed a Rule 60 continuation application and a Rule 131 affidavit to overcome the principal prior art relied upon in the appealed case. Next, counsel scheduled an interview for February 14, 1997. Examiner Matar said that he normally did not work on Fridays, and February 14 was not only a Friday but his anniversary as well, so he was reluctant to hold an interview on that date. Counsel stated that the date was essential because he had to be in Florida on February 13, and no change was possible in that court appearance in which twenty cases were being heard. Because counsel comes from San Francisco, and the trip had already been scheduled, Examiner Matar reluctantly agreed to the interview on February 14.

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On February 14, Examiner Matar was not in the office, so undersigned counsel asked to speak to the supervisor, Examiner Zele. She contacted Examiner Matar at home, and he denied ever agreeing to the interview, and had no record of any obligation on February 14, normally his day off.

Examiner Zele was gracious enough to review the file over the lunch hour and to grant an interview after lunch. Examiner Zele agreed that the primary rejection of the parent case, grounded on an article in the Economist magazine called "IDT," was not sound in constituting evidence tracing back two and one half years before the date of the article to establish a date in 1990. The Economist magazine is not a "statutory bar" as of September 12, 1990, contrary to the assertions on page 21 of the Official Action. In the interview summary, Examiner Zele reported that she urged greater specificity in the 131 affidavit, which was immediately provided.

Undersigned counsel also filed a Petition to Make Special before a Serial Number was assigned to this case, with a courtesy copy to Examiner Matar. The official Petition apparently got lost because it did not have the Serial Number of the case. Undersigned counsel repeatedly asked Examiner Matar to examine the case, but he refused because he only had courtesy copies of documents, and an official file had not been assembled. No action on the Petition to Make Special was taken for months.

Finally, new counsel filed a Petition for Writ of Mandamus in the United States Court of Appeals for the Federal Circuit. Once the Solicitor's office was involved, the Petition to Make Special was promptly granted. Examiner Matar still refused to

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examine the case on the grounds that he had numerous other Special cases that had older dates than the present one. Undersigned counsel was in Washington, D.C. on August 5, 1997, and asked twice for the opportunity to discuss the case at that time. Examiner Matar said he was not prepared to discuss the case and would not see me. In late August, Examiner Matar called on the telephone to request a new preliminary amendment, which was promptly provided. Undersigned counsel asked whether a search had been conducted, and Examiner said that he had conducted a further search and that he had new prior art. When counsel asked for the identity of the new prior art, Examiner Matar said he had not decided how it would be combined, so he refused to disclose the closest prior art. Finally, on August 29, 1997, an Official Action was mailed.

The Official Action comes six months after the interview, and repeats exactly the same rejection as was overcome in the interview, namely the assumption that the Economist article was dated two and one-half years prior to the date it bears. Instead of advancing the prosecution, applicant has endured a six month delay, and the interview is totally ignored.

Worse, the Official Action represents a step backward from the state of the prosecution at the time of the Examiner's Answer in the appeal of the parent case. In the Answer dated June 1, 1995, Examiner Matar relied on the combination of Kahn, Billinger and Srinivasan for a rejection under Section 103 of the patent law (page 8). Now, the Examiner relies upon Kahn alone for a 35 U.S.C. § 102(b) rejection (page 4).

new
claims

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Kahn has nothing whatsoever to do with international call-back. The Examiner acknowledged in his Examiner's Answer that Kahn differs from the claimed invention in that it teaches that the Kahn system "answers the call and the subscriber manually provides a security code" (page 8, emphasis present). How can that be an anticipation of claims that require "subscriber terminates the call to the service center" (claim 18, step (d))? It is dead wrong to hold that Kahn anticipates these claims. Two years ago, it was admitted that Kahn does not anticipate, and we are now going backward in the examination process.

*Art. 18
claims*

The Examiner states that Kahn "teaches that the calling party can hang up" (page 5 of the Official Action), when it merely states that the calling party can dial his own number in order to have the system interconnect to his phone number. If he did not hang up, there would be a busy signal when the system enters his telephone number. There would be no cost savings in Kahn, which does not purport to save money, because there would be a first completed call from the caller to the system, then a second completed call from the system to the caller, then a third completed call to the called party, then a fourth completed call to a conference participant. Kahn certainly does not have "optimizing service economy" as the title of the present invention specifies. The beauty of the present invention is that there are only two relatively inexpensive calls: one from the system to the subscriber, and the other from the system to the called party. If the system is in the United States, where costs are

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low, both calls are substantially less than a call from a foreign country to the United States.

The claims call for the service center to call an assigned subscriber identifier (claim 18) or comparing "stored data" (claim 1). Kahn has no such stored subscriber number. Rather, "by dialing his own number of the outgoing line and then hanging up, the caller can then have the system call him back" (Abstract, right column, lines 7-9). This is not anticipation, and the present invention is not obvious in view of Kahn.

not claimed

The Examiner mistakenly assumes that international call back is merely Automatic Number Identification (ANI). The Billinger reference is then combined with Kahn (pages 7-9) to reject the claims under Section 103. For there to be a valid 103 rejection, there must be some teaching or reason to make the combination, and the combination must meet the claimed elements. Here, the primary teaching of Kahn is that a remote caller can interconnect to other called parties. There is nothing in Kahn to suggest or to teach the concept of international call-back, a multi-million dollar industry. If Kahn is combined with Billinger, as the Examiner suggests, the logical consequence is ANI numbers in interconnected calls. The Examiner acknowledged as much in the Examiner's Answer in the parent case, where he stated that Kahn and Billinger could be combined to make it "obvious to utilize the information provided automatically by the telephone company (ANI) to automatically identify the originating station" (page 9, emphasis present). This in no way teaches the invention of the present claims. The Examiner in the parent case relied upon a third reference

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not cited now

(Srinivasan) to suggest that ANI and DID are interchangeable (page 10 of Examiner's Answer). The issue in the parent case was narrowed to Kahn in view of Billinger and Srinivasan, but in this Rule 60 continuation, the Examiner now argues that either Kahn alone or Kahn and Billinger are sufficient to reject the claims. This prosecution is going in the wrong direction. None of the cited references has anything to do with international call-back, so the rejections should be withdrawn.

not claimed

ANI has nothing to do with international call-back, because it is not available overseas. What we know today as "caller ID" is an application of ANI that provides the telephone number of the calling party to the called party before the called party picks up the telephone. ANI does not carry forward to the end user, a called party in a foreign country. ANI is not available in the markets where international call-back is used, so Billinger is not relevant to the present invention, which does not use ANI. DID is not the same as ANI, but the Examiner in this case does not rely on the Srinivasan reference relied upon in the appeal of the parent case. *not claimed*

search not complete

In paragraph 10 of the Official Action (pages 9-12), claims are rejected on the combination of Kahn and Curtin. Apparently Curtin was the new prior art that the Examiner said he had found, but refused to identify to counsel on request. Curtin was not cited in the parent case. As the abstract states, Curtin relates to an apparatus "for identifying who is placing a call to a telephone prior to answering." It does indeed disclose multiple DID access lines, but only in conjunction with a central system. It has nothing to do with international call-back, an important industry that uses the present

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invention widely. The invention is not the use of DID access lines in a central system. That is acknowledged prior art. However, the combination of Kahn and Curtin is tenuous. Kahn teaches manual entry of a code to identify the caller, as the Examiner acknowledges (page 10). Curtin teaches that this technique is "disadvantageous and undesirable" according to the Examiner (page 10, emphasis present). Thus, the clear teaching of Curtin is **not** to do what Kahn teaches. How can that be a teaching of international call-back? Kahn teaches that a caller can dial in his own number to the system, then hang up and the system calls him back. The caller using the Kahn apparatus already knows who is calling because the caller entered his own number. What is the need for a display of the number of the caller, as provided in Curtin, when the caller has dialed in his own number? It is a ridiculous rejection.

Neither Kahn nor Curtin suggests the steps of calling a service center, terminating the call, having the service center call the subscriber back, the subscriber enters the number desired, and the service center bridges subscriber to called party. If it were so obvious, why did no one in the prior art ever disclose it? None of the cited patents has anything whatsoever to do with international call-back.

Beginning with paragraph 11 on page 12 of the Official Action through page 22, the Examiner has resurrected the IDT rejection. The rejection is utterly lacking in factual support for anything prior to September 12, 1992, the date of the publication. The Examiner says that it proves "that the IDT machine was made and used 2 1/2 years before the publication date" (page 13, emphasis present). All the article says is

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that the *company* is two and one half years old. This is not proof of anything having been made or used. Paragon International was incorporated in December 1988, long prior to the formation of IDT in 1990. That is not proof of anything. It certainly is not proof that the invention was in public use or published before September 12, 1992.

Examiner Zele agreed with this proposition on February 14, 1997.

It is ironic that the Examiner goes to great pains to state that the exhibits attached to the Rule 131 declaration are not adequate because "there is no mention of any claimed feature whatsoever" (Official Action, page 18), and yet all of the magazine articles are even less informative of structure. The Examiner cannot have it both ways: if he insists on "sketches, description, blue prints of 'the router'" (page 18), he should point out where in the claims a router is called for. The magazine articles do not have any "sketches, description, blue prints" of any structure, so it is improper to require different standards of proof for the Rule 131 Declaration that the Examiner requires for cited prior art. If blue prints are required, then the rejection based on IDT fails.

Likewise, at page 19, the Examiner inquires about "software for the claimed invention." The invention is not software. It is idle speculation to assume that the present invention "required software which was completed by Mr. Gunther in September 1990 and hardware which was 'completed' by Call Interactive" (page 19). The inventor is James Alleman, not Mr. Gunther or Call Interactive. Mr. Alleman has sworn that he is the inventor. It is error for the Examiner to assume that Mr. Alleman is not the inventor. What is important about the exhibits are the dates, which clearly

reduction
to
practice

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precede the dates in Examiner's Exhibit A. This is not an interference or priority contest, where blueprints might be important. Rather, it is a matter of a relatively simple invention being made before the dates of the cited art. The Inventor has sworn to the dates, and the Examiner must accept them, unless there is some reason to suspect perjury.

Applicant has clearly shown dates prior to the date of publication of IDT, so the rejection must fall. If IDT has better prior art than the Examiner does, then it will come out in future litigation. The Examiner is merely engaging in wishful thinking; Examiner's Exhibit A is worthless as prior art.

At page 21 of the Official Action, the Examiner states that "Applicant admits on pages 3 and 4 of the specification that the IDT machine is prior art." Nowhere in pages 3 and 4 do the letters "IDT" appear. The fact that a New York Times article dated January 9, 1992 is referred to on page 4 does not mean that the inventor cannot swear behind that date. There has never been a case where an inventor was barred from filing a Rule 131 affidavit to overcome prior art referred to in a specification. The Examiner is wrong as a matter of law.

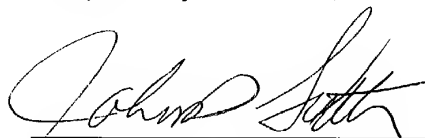
In paragraph 14, the Examiner challenges the sworn statement of Mr. Wyatt under Rule 132 that the invention has enjoyed commercial success. There can be no doubt that the six steps described on page 82 of the Teleconnect article are the present invention. There can be no doubt that the magazine concludes that those practicing those steps are included in the conclusion on page 84: "Result: a billion-dollar

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business, worldwide." The Examiner is mistaken in finding as a matter of fact that the article is about equipment and systems "that are different from the claimed invention." (page 23, emphasis present). The billion dollar industry is using the six steps that are claimed in the present application. The nexus is clear, and the Examiner has no basis for refuting the sworn statement of Mr. Wyatt. The secondary consideration of commercial success may be considered in overcoming a *prima facie* case of obviousness. It is error to simply disregard sworn testimony in preference to prior patents that make no mention whatsoever to the international call-back invention. At least the Teleconnect article is relevant to the subject matter of the application. The cited patents are not. The cited articles in Exhibit A are all too late to have any value as prior art.

It is submitted that all claims are allowable and only the drawings remain to be corrected. Favorable action is solicited.

Respectfully submitted,



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